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### REMARKS

This is in response to the non-final Office Action mailed September 20, 2005. In the Action, the Examiner notes that claims 1-16 are pending and rejected. By this response, 1, 7, 12, 15 and 16 are amended.

In view of the foregoing amendments and the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

### REJECTIONS

#### **35 U.S.C. §103**

##### Claims 1-16

The Examiner has rejected claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over Schein et al. (U.S. Patent No. 6,002,394, hereinafter "Schein") in view of Lawler et al. (U.S. Patent No. 5,907,323, hereinafter "Lawler"). Applicants respectfully traverse the rejection.

Applicants' independent claims 1, 7, 12 and 15-16 recite different aspects of the present invention including the limitation for the terminals to receive group assignment rules from a remote location such as the local insertion center. Specifically, Applicants' independent claim 1 (and similarly independent claims 7, 12 and 15-16) recites:

1. A method for presenting editorial content items on a display device within the context of an electronic program guide, the electronic program guide operative to display information regarding programming available on a broadcast distribution network, the method comprising:  
receiving and storing an editorial content index page and one or more editorial content items at a client device,

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wherein the editorial content index page includes one or more links to the editorial content items;  
while the electronic program guide is displayed, selecting a control to present the editorial content index page on the display device;  
recovering and displaying the stored editorial content index page;  
selecting a link to an editorial content item from the set of one or more links;  
if the editorial content item of the selected link comprises a video item, determining if a video-on-demand (VOD) software is installed on the set top terminal (STT), tuning the client device to a video-on-demand channel if the VOD software is installed, else retrieving the video item from an in-band channel if the STT lacks the VOD software; and  
recovering and presenting the editorial content item on the display device. (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (C.C.P.A. 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d. 1382, 1385, 165 USPQ 494 496 (C.C.P.A. 1970), M.P.E.P. 2143.03. Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Schein and Lawler references alone or in combination fail to teach or suggest Applicant's invention as a whole.

Specifically, the Schein and Lawler references alone or in combination, fail to teach or suggest at least "if the editorial content item of the selected link comprises a video item, determining if a video-on-demand (VOD) software is installed on the set top terminal (STT), tuning the client device to a video-on-demand channel if the VOD

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software is installed, else retrieving the video item from an in-band channel if the STT lacks the VOD software."

Schein provides television schedule information to viewers and allows them to link, search, select and interact with information in a remote database. Schein fails to disclose each and every element of the present claims. Specifically, Schein is silent regarding tuning the set top terminal to a VOD channel in order to render the video data if a link includes a video item. Therefore, Schein does not disclose, teach or suggest "if the editorial content item of the selected link comprises a video item, determining if a video-on-demand (VOD) software is installed on the set top terminal (STT), tuning the client device to a video-on-demand channel if the VOD software is installed, else retrieving the video item from an in-band channel if the STT lacks the VOD software."

Lawler discloses displaying summary information relating to programming available on an interactive television or televideo system. A preview display window shows video clips or segments of multiple frames would be rendered in the preview window for interactive services, VOD services, etc. (i.e., column 9, lines 49-59). Lawler fails to teach or suggest Applicants' "if the editorial content item of the selected link comprises a video item, determining if a video-on-demand (VOD) software is installed on the set top terminal (STT), tuning the client device to a video-on-demand channel if the VOD software is installed, else retrieving the video item from an in-band channel if the STT lacks the VOD software."

There is no motivation to combine Schein and Lawler because Schein does not desire the tuning method of Lawler. Schein already discloses watches programming and previews in display windows 526, 528. Therefore, there is no motivation to include the tuning method of using pointers and tables as taught by Lawler to perform the same functions as Schein. Furthermore, the tuning method using pointers and tables appear to not be compatible with the system of Schein. Even if operable combined, Schein in view of Lawler still lacks "if the editorial content item of the selected link comprises a video item, determining if a video-on-demand (VOD) software is installed on the set top terminal (STT), tuning the client device to a video-on-demand channel if the VOD

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software is installed, else retrieving the video item from an in-band channel if the STT lacks the VOD software."

As such, Applicants submit that independent claims 1, 7, 12 and 15-16 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2-6, 8-11, and 13-14 depend, either directly or indirectly, from independent claims 1, 7 and 12 and recite additional limitations thereof. As such, and at least for the same reasons as discussed above, Applicants submit that these dependent claims fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

### CONCLUSION

Thus, Applicants submit that all of the claims presently in the application are non-obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jasper Kwoh at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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